UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
	10/849,511	VANYO ET AL.
Office Action Summary	Examiner	Art Unit	
	RAHEEM HOFFLER	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 November 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>19 May 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detailed Action

Reopening of Prosecution After Appeal

In view of the Appeal Brief filed on 11/19/2007, PROSECUTION IS HEREBY

REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an

appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee

can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference

between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing

below:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 8, 10, and 13-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 8, 10, 12, 14 and 15 of copending Application No. 10849473 (Vanyo et al) in view of sharing a common Inventors and Assignees. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 1 of U.S. PG Pub No. 10849473	Claim 1 of this application
An apparatus comprising:	An apparatus comprising:
A user terminal which generates a first service request,	A user terminal which generates a user request,
A publicly accessible digital data communication network responsively coupled	A publicly accessible digital data communication network responsively coupled

to said user terminal,	to said user terminal,
A legacy data base management system responsively coupled to said user terminal via said publicly accessible digital data communication network which receives said first service request,	A legacy data base management system having access to at least one data base responsively coupled to said user terminal via said publicly accessible digital data communication network, and
A legacy data base incompatible with, but responsively coupled to, said data base management system, and A facility responsively coupled to said legacy data base management system and said legacy data base which permits said legacy data base management system to access said legacy data base in response to said receipt of said first service request.	a stored procedure having a sequence of command script statements responsively coupled to said legacy data base management system which is executed in response to said user request.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Note the comparison above, Claim 1 of U.S. PG Pub No. 10849473 teaches of An apparatus comprising a user terminal which generates a first service request, a publicly accessible digital data communication network responsively coupled to said user terminal, a legacy data base management system responsively coupled to said user terminal via said publicly accessible digital data communication network which receives said first service request, a legacy data base incompatible with, but responsively coupled to, said data base management

system and a facility responsively coupled to said legacy data base management system and said legacy data base which permits said legacy data base management system to access said legacy data base in response to said receipt of said first service request. Claim 1 of this application claims a number of elements that are commonly shared by U.S. PG Pub No. 10849473. This application differs in that it teaches of a stored procedure having a sequence of command script statements responsively coupled to said legacy data base management system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to remove the legacy database taught by Vanyo et al and include a sequence of command script statements responsively coupled to said legacy database management system executed in response to said user request because of the opportunity to define, initialize, and execute stored procedures.

Depending claims 2, 4-5, 7, 9, 12, and 17-20 further limit the claims made by this application that are not met by U.S. PG Pub No. 10849473. For example, claim 4 of this application recites the limitation "The apparatus ... wherein said at least one data base further comprises an OLEDB data base."

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6, 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the clause "said publicly accessible digital data base management system" references to other items in the claim. It is unclear what item is being referenced by the clause.

In claim 7, the clause "said command language script" references to other items in the claim. It is unclear what item is being referenced by the clause.

Claim 11 is vague and indefinite because the steps in the body of the claim recite the limitation of "means for..." which has been reasonably construed as the attempt by Applicant to invoke 35 U.S.C. 112, sixth paragraph. However, the metes and bounds of the claim have not been specifically defined for the limitation of "means for..." in the specification. The instant disclosure does not define the structures necessary for each "means for 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). (See MPEP 2181 [R-2]).

In claim 16, the clause "the improvement", located within the preamble of the claim, references to other items in the claim. It is unclear what item should be improved and is being referenced by the clause.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As recited in claim 16, the recited "the improvement" appeared to be a program or data structure. If it's a program, a memory is missing. If it's a data structure, the data structure comprising non functional descriptive materials. A program without a memory or a data structure comprising non functional descriptive materials is non statutory.

Claim 21 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

With respect to claim 21, the recited apparatus comprising "a user terminal", "a publicly accessible digital data communication network", a "legacy data base management system" and "a stored procedure". In light of the specification of the current invention, "user terminal" and "legacy data base management system" are two different computers. The "publicly accessible digital data communication network" is a conventional network such as LAN or WAN (Specification, page 11 lines 9-19. An apparatus is a single device or appliance. No single device or apparatus is able to include two separated and different computers that connected by a network such as LAN or WAN. Therefore, the recited apparatus comprising those features is inoperative and therefore lacks utility.

Claim Rejections – 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Eastwick et al

(US Patent No. 6240417B1).

As for Claim 1, Eastwick et al clearly teaches a user terminal which generates a user

request (e.g., workstation; (col. 2, lines 11-14)(col. 3, lines 65-67- col. 4, lines 1-3)(col.

4, lines 4-22)); b. a publicly accessible digital data communication network responsively

coupled to said user terminal (e.g., "any communication connection"; (col. 3, lines 65-67

– col. 4, lines 1-3)); c. a legacy data base management system having access to at

least one data base responsively coupled to said user terminal via said publicly

accessible digital data communication network (col. 1, lines 56-59; col. 3, lines 13-25);

and c. a stored procedure having a sequence of command script statements

responsively coupled to said legacy data base management system which is executed

in response to said user request (e.g., database integrator; (col. 1, lines 59-67- col. 2,

lines 1-10)(col. 3, lines 25-51)(col. 4, lines 34-42)).

As for Claim 2, Eastwick et al teaches a user terminal generates a second user request which causes said legacy data base management system to add parameters to said stored procedure (col. 6, lines 55-61; col. 7, lines 20-27).

As for Claim 3, Eastwick et al teaches at least one database further comprises an ODBC database (col. 3, lines 13-16; col. 7, lines 33-36).

As for Claim 4, Eastwick et al teaches at least one database further comprises an OLEDB database (col. 3, lines 13-16; col. 7, lines 33-36). OLEDB can be an equivalent of ODBC and used in its place. OLEDB is commonly known in the art by definition as an open specification that can interface with all types of data files on a computer network.

As for Claim 5, Eastwick et al teaches a legacy database management system further comprises BIS (col. 1, lines 56-59; col. 3, lines 13-25; whereas Eastwick's teachings of a software interface in conjunction with legacy data in a database reads on Applicant's claim language involving a BIS).

As for Claim 6, Eastwick et al teaches a. transmitting a service request requesting access to said command language scripted stored procedure from said user terminal to said legacy data base management system via a publicly accessible digital data communication network (col. 2, lines 11-14)(col. 3, lines 65-67- col. 4, lines 1-3)(col. 4, lines 4-22); b. receiving said service request by said legacy data base management system (e.g., integration component; col. 2, lines 23-33); c. accessing said command language scripted stored procedure in accordance with said service request (e.g., database integrator; (col. 1, lines 59-67- col. 2,

lines 1-10)(col. 3, lines 25-51)(col. 4, lines 34-42)); and d. transferring an appropriate response

from said legacy data base management system to said user terminal via said publicly

accessible digital data base management system (col. 1, lines 59-67- col. 2, lines 1-10).

As for Claim 7, Eastwick et al teaches executing said command language script

corresponding to said service request (e.g., database integrator; (col. 1, lines 59-67- col. 2, lines

1-10)(col. 3, lines 25-51)(col. 4, lines 34-42)).

As for Claim 8, Eastwick et al teaches a publicly accessible digital data communication

network further comprises the Internet (col. 3, lines 65-67 – col. 4, lines 1-3).

As for Claim 9, Eastwick et al teaches transferring a second service request from said

user terminal to said legacy database management system which causes said accessing step to

enter parameters into said command language scripted stored procedure (e.g.,

input/parameters; col. 6, lines 55-61; col. 7, lines 20-27).

Claims 10, 14, and 20 differ from Claim 5 in that claim 10 is a method, claim 14 is an

apparatus, and claim 20 is an improvement whereas claim 5 is apparatus claim. Thus, claims

10, 14, and 20 are analyzed as previously discussed with respect to claim 5 above.

As for Claim 11, Eastwick et al teaches a. permitting means for permitting a user to

transfer a service request via a publicly accessible digital data communication network (col. 3,

lines 65-67 – col. 4, lines 1-3); b. offering means responsively coupled to said/permitting means

via said publicly accessible digital data communication network for offering legacy data base

management services involving access to at least one data base having a scripted command language stored procedure (col. 1, lines 56-59; col. 3, lines 13-25); and c. accessing means responsively coupled to said offering means for accessing said scripted command language stored procedure in response to said service request (e.g., navigator/terminal emulator; col. 4, lines 42-44, 56-62; col. 6, lines 39-67- col. 7, lines 1-5).

Claim 12 differs from Claim 7 in that claim 12 is an apparatus whereas claim 7 is a method claim. Thus, claim 12 is analyzed as previously discussed with respect to claim 7 above.

As for Claim 13, Eastwick et al teaches a generating means located within said permitting means for generating a second service request (e.g., navigator; col. 4, lines 56-62; col. 6, lines 39-67- col. 7, lines 1-5).

As for Claim 15, Eastwick et al teaches a permitting means further comprises an industry standard personal computer (e.g., workstation; (col. 2, lines 11-14)(col. 3, lines 65-67- col. 4, lines 1-3)(col. 4, lines 4-22)).

Claim 16 differs from Claim 11 in that claim 16 is an improvement whereas claim 11 is an apparatus claim. Thus, claim 16 is analyzed as previously discussed with respect to claim 11 above.

As for Claim 17, Eastwick et al teaches a plurality of variables loaded into said scripted command language stored procedure in response to said service request (e.g., input/parameters; col. 6, lines 55-61; col. 7, lines 20-27).

Claim 18 differs from Claim 2 in that claim 18 is an improvement whereas claim 2 is apparatus claim. Thus, claim 18 is analyzed as previously discussed with respect to claim 2 above.

Claim 19 differs from Claim 8 in that claim 19 is an improvement whereas claim 8 is method claim. Thus, claim 19 is analyzed as previously discussed with respect to claim 8 above.

Claim 21 differs from Claim 1 in that claim 21 is an apparatus for permitting a user to access a stored procedure whereas claim 1 is an apparatus claim. Thus, claim 21 is analyzed as previously discussed with respect to claim 1 above.

Response to Arguments

Applicant's arguments with respect to claims 1-21 have been fully considered but are not persuasive in view of the original grounds of rejection.

With respect to applicant's argument that:

"…Though Applicants' claims have differing limitations and scopes, each is based upon the key feature of a "stored procedure", located in the legacy data base which is executed by the legacy data base management system in response to a request by the user terminal coupled via a publicly accessible network. Eastwick, on the hand, does not have the disclosed and claimed "stored procedure". Therefore, the Examiner has attempted to read this limitation onto "database integrator" 314 disclosed by Eastwick. The "database integrator" 314 of Eastwick is readily distinguishable from Applicants' "stored procedure" in that the "database integrator" 314 is located within memory 302 of workstation 102 (see Fig. 3 and corresponding description at column 4, lines 23-29), rather than in the legacy database. As a result, "database integrator" 314 is executed by workstation 102 rather than by a legacy data base management

system. Thus, the "database integrator" 314 is not coupled to workstation 102 by a network, but is coupled through an internal memory bus...it is clear that Eastwick cannot meet this limitation, because it does not have the claimed "publicly accessible" coupling network. Claim 2 depends from claim 1 and is further limited by "wherein said user terminal generates a second user request which causes said legacy data base management system to add parameters to said stored procedure"

Examiner is not persuaded. The above argument is not persuasive because the relied upon reference of Eastwick et al does in fact teach of stored procedures taught by Applicant. Eastwick et al teaches a data integrator, which performs the tasks being executed by the Applicant's stored procedures, by converting commands received by an ODBC interface into server program-specific commands to manipulate the user interface of a server program (see col. 1, lines 59-67; col. 2, lines 1-10; col. 3, lines 25-51; col. 4, 34-42). Examiner maintains that "database integrator" 314 an also be coupled with the legacy database management system, as taught by Eastwick in (see col. 3, lines 52-62) in which it is stated that "...one skilled in the art will appreciate that an alternative embodiment may provide a client program with access to a legacy DBMS that is on the same computer." Parameters added to a stored procedure or command is taught within (col. 6, lines 55-61; col. 7, lines 20-32), providing for user input.

With respect to applicant's argument that:

"Claim 5 depends from claim 4 and further limits the claimed data base management system. Because the Examiner realizes that Eastwick cannot meet this limitation, she irrelevantly states: .... whereas Eastwick's teachings of a software interface in conjunction with legacy data in a database reads on Applicant's claim language involving a BIS. This finding is legally irrelevant, because it does not address Applicants' claimed invention. Furthermore, even if relevant, it is inadequate as a matter of law, because it does not show the "identical invention in as complete detail as is contained in the claim" as is explicitly required by MPEP 2131."

Examiner is not persuaded and maintains that Eastwick et al teachings of a software interface read upon Applicant's claim language involving a BIS. Eastwick's software interface utilizes various high-level instructions whereby the database user may manipulate the database to generate human-readable data presentations.

With respect to applicant's argument that:

"

Claim 6 is an independent method claim having four key steps. Claim 6 is "method of utilizing a user
terminal to access a command language scripted stored procedure within a legacy data base
management system having at least one data base". The claim requires that the claimed "stored
procedure" be located "with a legacy data base management system". Ignoring Applicants' claimed
invention, the Examiner clearly erroneously finds:
        Eastwick et al. teaches a. transmitting a service request requesting access to said command
language scripted stored procedure....
The request (if any) is not "transmitted" as found by the Examiner, because the alleged "stored
procedure" is located within workstation 102, as explained above. The second claimed step requires
"receiving said service request by said legacy data base management system". This step is not found in
Eastwick, because the request (if any) must be modified by "database integrator" 314 before transfer from
workstation 102. As a result, the claimed "request" is neither "transmitted" (i.e., step a) or "received" (i.e.,
step b) as claimed, but is simply converted by "database integrator" 314 within workstation 102."

Examiner is not persuaded and maintains that Eastwick et al teachings read upon

Applicant's claim language. Within Claim 6 (a) Applicant refers to a service request accessing

said stored procedure as being transmitted from "a user terminal to said legacy database

management system via a publicly accessible digital data communication network" whereas

Eastwick et al teaches communicating a request for stored commands between a user terminal

and a legacy DBMS via a "communication connection". Eastwick's communication connection

reads on Applicant's claim language of a publicly accessible digital data communication

network. The legacy DBMS receives the transmitted request from the database integrator by

way of its server program, which accesses the requested data and provides an appropriate

response by displaying the appropriate data on its user interface (see col. 3, lines 13-51).

With respect to applicant's argument that:

"Claim 11 is an independent apparatus claim having three "means-plus-function" limitations. The
second element is "offering means responsively coupled to said permitting means via said publicly
accessible digital data communication network for offering legacy data base management services
involving access to at least one data base having a scripted command language stored procedure". It
specifically requires that the claimed "stored procedure" be located within the claimed "data base" of the
claimed "offering means". Nevertheless, in finding the third claimed element, the Examiner completely

ignore claim element b and again relies upon functions performed within workstation 102. As explained above, the claimed "stored procedure" is executed by the claimed "offering means".

Examiner is not persuaded and maintains that Eastwick et al teachings read upon Applicant's claim language. Eastwick et al teaches of accessing at least one database having a scripted command language stored procedure (see col. 4, lines 23-34). Examiner maintains rejection of claim 11.

Conclusion

The prior art made of reference and not relied upon is considered pertinent to Applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAHEEM HOFFLER whose telephone number is (571)270-1036. The examiner can normally be reached on 7:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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